

REMARKS/ARGUMENTS

These remarks are offered in response to the Office Action of December 14, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 2 of the Office Action, the Examiner has rejected claims 1-17 and 21-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,772,188 to Cloutier (Cloutier). In paragraphs 3 through 5, the Examiner has rejected claims 18-20 and 38-40 under U.S.C. § 103(a) as being unpatentable over Cloutier in view of U.S. Patent No. 5,937,162 to Funk, *et al.* (Funk). In paragraph 6, the Examiner has rejected claims 41-43 under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,680,551 to Martino, II (Martino) in view of Cloutier. Finally, the Examiner rejected claim 44 in paragraph 7 under 35 U.S.C. § 103(a) as being unpatentable over Cloutier in view of Martino and in further view of Funk.

In response to the Office Action, Applicants have enclosed Declarations under 37 C.F.R. § 1.131 supporting the removal of Cloutier as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0050 (Disclosure) entitled "E-mail Client With 'Reply by Voice/Phone Conversation' Feature". The Disclosure and Declarations demonstrate proof of conception for the claimed subject-matter of Applicants' invention at least as early as June 07, 2000, the submitted date of the Disclosure, which predates the effective date of Cloutier (July 14, 2000).

The Disclosure represents the completion of an internal International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the

Disclosure once the Disclosure has been completed. Any changes and/or additions to the disclosure after the submitted date are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since June 07, 2000.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declaration, prior to submission of the application to the USPTO, the inventors reviewed the application to insure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Cloutier until July 19, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declaration, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application.

Instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Cloutier and exercised due diligence in constructively reducing the invention to practice

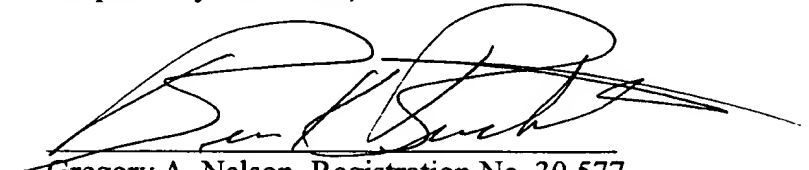
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Regarding Office Action dated Dec. 14, 2004
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between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Cloutier should be withdrawn as a reference. Withdrawal of Cloutier should result in the withdrawal of the rejections to claims 1-44 that are based upon Cloutier, which action is respectfully requested.

In light of the above, Applicants believe that this application is now in full condition for allowance. Allowance is therefore respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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